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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/747,660 | 12/22/2000 | Stephen M. Smith | LAM2P216 | 9842 |
| 25920 | 7590 | 11/17/2003 | EXAMINER | |
| MARTINE & PENILLA, LLP 710 LAKEWAY DRIVE SUITE 170 SUNNYVALE, CA 94085 | | | WINTER, GENTLE E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1746 | 18 |

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

ab 17

Office Action Summary

Application No.

09/747,660

Applicant(s)

SMITH ET AL.

Examiner

Gentle E. Winter

Art Unit

1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-12 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-12 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 17.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1746

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/26/2003 has been entered.

Response to Arguments

Claim Objections—Maintained

Claims 4, 5, 11, 12, 18, and 19 were objected to under 37 CFR 1.75(c), as being of improper dependent form.

1. As to claims 4, 5, 11, 12, 18, and 19, said claims have been amended. Applicant has included a future intended use limitation.
2. The claims are drawn to a future intended use of the apparatus, and as such fail to further limit the apparatus.

Claim Rejections - 35 USC § 102—Withdrawn

3. Claims 1-5 were rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 4,654,522 to Gornick et al.

Applicant argued:

In contrast to the Office's assertion, any plate is not potentially a wafer backside plate because the wafer backside plate, as defined in the specification of the subject application, provides specific functions.

2. The claims must recite the indicated limitations, it is generally improper for the Office to read limitations from the specification into the claims. Currently it appears that Applicant is attempting to define the apparatus by what it does. While this may be an acceptable method of claiming an apparatus, pursuant to the sixth paragraph of 35 U.S.C. §112. A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase “means for ” or “step for ”;
- (B) the “means for ” or “step for ” must be modified by functional language;
and
- (C) the phrase “means for ” or “step for ” must not be modified by sufficient structure, material or acts for achieving the specified function.

3. With respect to the first prong of this analysis, a claim element that does not include the phrase “means for” or “step for” will not be considered to invoke 35 U.S.C. 112, sixth paragraph. If an applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant must either: (A) amend the claim to include the phrase “means for” or “step for” in accordance with these guidelines; or (B) show that even though the phrase “means for” or “step for” is not used, the claim limitation is written as a function to be performed and does not recite sufficient structure, material, or acts which would preclude application of 35 U.S.C. 112 , sixth paragraph. See *Watts v. XL Systems, Inc.*, 232 F.3d 877, 56 USPQ2d 1836 (Fed. Cir. 2000) (Claim limitations were held not to invoke 35 U.S.C. 112, sixth paragraph because the absence of the term “means ” raised the presumption that the limitations were not in means-plus-function

Art Unit: 1746

form, nor was the presumption rebutted.) It is not clear why Applicant does not include the structure of the apparatus that is to be claimed. Applicant argues that the mass reducing apertures of Gonzalez would not work with the present invention because the wafer would be re-contaminated. The argument may be wholly correct, but Applicants' claims seemingly allow for the same aperture.

4. Applicant also argues that the prior art platform does not automatically move based on centrifugal gravity. Applicant's arguments are drawn to an occurrence dependant on the use of the apparatus, applicant has include no hint of structure that would allow the disclosed function to occur. However, it is not clear that Gonzalez could function in the manner claimed, therefore the rejection is withdrawn.

4. Claims 1-5, 8-12, and 15-19 were rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 4,788,994 to Shinbara. Applicant argues that the rotary plate of Shinbara does not slide between an up position and a down position resulting from centrifugal gravity. The argument is persuasive as indicated above.

Claim Rejections - 35 USC § 112-New

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1746

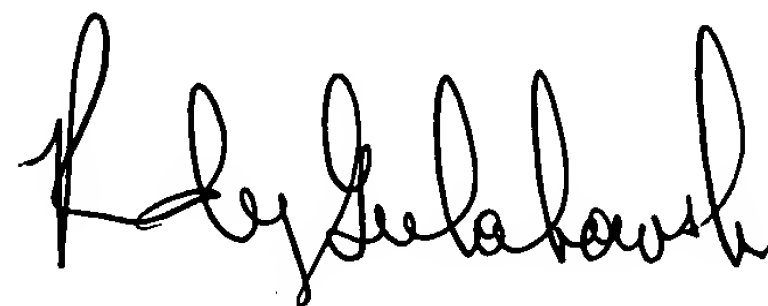
6. Claims 1-5, 8-12 and 15-19 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The manner in which centrifugal force is operative to produce the claimed effects is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The claims lack any biased structure or other centrifugally operative structure.

Conclusion

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gentle E. Winter whose telephone number is (703) 305-3403. The examiner can normally be reached on Monday-Friday, 8:30-5:00.
2. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (703) 308-4333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.
3. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Gentle E. Winter
Examiner
Art Unit 1746

November 6, 2003



RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700